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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,785	09/15/2003	Simon Berners Hall	358261-991100	9521
26379 7590 03/28/2007 DLA PIPER RUDNICK GRAY CARY US, LLP 2000 UNIVERSITY AVENUE E. PALO ALTO, CA 94303-2248			EXAMINER WALKER, KEITH D	
			ART UNIT 1745	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE 3 MONTHS		MAIL DATE 03/28/2007	DELIVERY MODE PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/662,785

Applicant(s)

HALL ET AL.

Examiner

Keith Walker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/19/07 has been entered.

Claims 25-40 are pending examination.

Claim Interpretation

The preamble has been amended to read, "A method of preparing a zinc electrode composition". Prefacing the composition with 'zinc electrode' does not change the interpretation of intended use. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction (MPEP 2111).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 25-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,827,494 (Yano) in view of US Patent 4,297,249 (Przybyla).

Yano teaches the process of making an electrode by adding a precipitated zinc hydroxide with a salt of a mineral acid such as zinc sulfate (5:32-47).

Yano does not speak to the use of a fatty acid or graphite in the making of the electrode.

Przybyla teaches adding an alkali metal salt of a fatty acid, including the metal of potassium and a fatty acid of stearic acid, forming potassium stearate (5:26-33).

Graphite is added to the mixture to act as a lubricant (6:65-68). The metal salt of the fatty acid promotes a reduction of oxygen evolution and also acts as a lubricant by lowering the internal friction of the powder.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the electrode mix of Yano with the alkali metal salt of a fatty acid and graphite to aid in the lubrication of the powder as it is formed, which promotes a more consistent and uniform density to the electrode.

2. Claims 32-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yano in view of Przybyla as applied to claim 30 above, and further in view of US Patent 4,146,685 (Tucholski) as evidenced by US Patent 5,688,616 (Yamawaki).

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The teachings of Yano and Przybyla as discussed above are incorporated herein.

Yano and Przybyla teach the use of potassium stearate, forming zinc stearate when mixed, as a lubricant in the making of an electrode, but do not discuss the mix ratio or the use of calcium nitrate to make the calcium stearate.

Tucholski also teaches the use of stearates, such as zinc and calcium, as a lubricant or stabilizer and adds the stearates in the amount of about 0.5% (Table 1). Only a minor amount of the stearate is added to mixture to improve the flow and molding of the electrode but not detract from the electrical properties by lowering the density of the active material. Furthermore, it would have been obvious to one having ordinary skill at the time of the invention to vary the amount of the stearate to find the amount needed to promote proper electrode molding and formation, since it is held that discovering an optimum value of a result effective variable involves only routine skill in the art (*MPEP 2144.05*).

While Tucholski teaches the use of the calcium stearate, the use of calcium nitrate as a precursor is not taught. As discussed above, Yano teaches using zinc sulfate in the electrode. Yamawaki teaches and gives evidence to the use of calcium nitrate as a substitute salt for the zinc sulfate (7:47-51).

It would have been obvious to one skilled in the art at the time of the invention to use the calcium nitrate for the zinc sulfate and with the stearic acid, produce the calcium stearate, since it is held to be within the general skill of a worker in the art to select a

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known material on the basis of its suitability for the intended use as a ^m/_batter of obvious design choice (MPEP 2144.07)

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the electrode mixture of Yano and Przybyla with the amounts presented in Tucholski to improve the molding and forming of the electrode without diminishing the electrical density of the electrode.

Response to Arguments

Applicant's arguments filed 12/21/06 have been fully considered but they are not persuasive.

Applicant argues the teachings of the prior art are not relevant since they do not teach preparing a zinc electrode. As stated above, the claims are interpreted as being directed to a composition for use in a zinc electrode and the recitation with respect to the manner in which a claimed apparatus or method is to be used does not patentably differentiate it from the prior art (*Ex Parte Masham*, 2 USPQ 2d 1647 (1987)). If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is necessary to give life, meaning, and vitality to the claim, then the claim preamble should be construed as if in the balance of the claim (MPEP 2111.02). The preamble does not give 'life, meaning or vitality' to the claim but is only seen as a use for the composition, namely an electrode. Furthermore, the prior art of Yano teaches a nickel, cobalt and zinc electrode and therefore teaches a zinc

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electrode. The instant claims do not differentiate over the teachings of the prior art and therefore are obvious over the prior art as discussed above.

In response to applicant's argument that the prior art of Yano and Przybyla do not solve the same problem as the instant application, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Walker whose telephone number is 571-272-3458. The examiner can normally be reached on Mon. - Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

K. Walker

MARK RUTHKOSKY
PRIMARY EXAMINER



3-24-07